

REMARKS

Claims 12-24 are all the claims pending in the application.

By this Amendment, Applicant adds claim 24 which is clearly supported by the specification. No new subject matter has been entered.

I. Summary of the Office Action

Claims 12-14 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashihara (U.S. Patent No. 6,236,557) in view of Hilterbrick (U.S. Patent No. 3,538,361).

Claims 15, 16, 18 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashihara (U.S. Patent No. 6,236,557) in view of Adachi (U.S. Patent No. 5,550,415).

Claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashihara (U.S. Patent No. 6,236,557) in view of Adachi (U.S. Patent No. 5,550,415) and further in view of Nikawa (U.S. Patent No. 6,291,913).

Claims 20 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashihara (U.S. Patent No. 6,236,557) in view of Nikawa (U.S. Patent No. 6,291,913).

II. Preliminary matters

Initially, Applicant notes that the Examiner did not address the obviousness arguments regarding the rearrangement of the voltage regulator, surge absorber and connector, submitted in the Amendment filed May 30, 2008. (*See* May 30 Amendment, point #4, pages 11-12).

MPEP § 707.07(f) states that “[w]here the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment. Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.”

Accordingly, Applicant respectfully requests the Examiner properly address these obviousness arguments submitted in the May 30 Amendment and repeated, in most part, therein.

Further, Applicant respectfully submits that, if a new Office Action is forthcoming, *that Office Action should be made Non-Final.*

III. Prior Art Rejections

Claims 12-14 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashihara (U.S. Patent No. 6,236,557) in view of Hilterbrick (U.S. Patent No. 3,538,361).

Claim 12 recites among other elements: “said voltage regulator, said surge absorber, and said connector are disposed radially outside said slinger alongside said brush holder on a first circumferential side of said brush holder.”

1. The Kashihara reference

The Examiner asserts that Kashihara teaches “the voltage regulator and the surge absorber being near the side of the brush holder, which would constitute these components being alongside the brush holder on the first circumferential side (see figure 10).” (*See* Office Action, page 3, lines 2-5).

However, claim 12 calls for all of the three components - the voltage regulator, surge absorber, *and* connector - to be disposed alongside the brush holder on a first circumferential side of the brush holder. Moreover, as argued in the May 30 Amendment, Kashihara does not teach or suggest a voltage regulator that is disposed *alongside* the brush holder and proximate to *only* the first circumferential side of the brush holder. As clearly seen in Figs. 2 and 10 of Kashihara, the voltage regulator has a wider circumferential width than the brush holder and overlaps with the brush holder to project beyond the brush holder on *both* first and second circumferential sides. Kashihara clearly teaches a voltage regulator that is disposed *at a rear side* of the brush holder and proximate to *both* first and second circumferential sides of the brush holder. Therefore, to the extent Kashihara discloses nearness of the voltage regulator to the brush motor, the voltage regulator is disposed near *the rear side* of the brush motor and *not alongside* a first circumferential side of the brush motor, as called for in claim 12.

Additionally, Kashihara teaches the capacitor, which is installed on one side of the slinger, projecting away from the slinger. (Col. 2, lines 22-27.) As shown in Fig. 10 of Kashihara, the capacitor is not positioned anywhere near one of the circumferential surfaces of

the brush holder, as the Examiner contends. To the contrary, claim 12 calls for the surge absorber to be disposed alongside the brush holder at a first circumferential side of the brush holder.

2. The Hilterbrick reference

Hilterbrick describes a dynamo-electric machine, including a stator 30, a rotor 48 and a slinger 22b are disposed in the right-hand side of the case 20. Brush holder 66a is disposed in the left-hand side of the case 20, in a chamber 58. The connector 100 is disposed in the left-hand top corner of the chamber 58. (Figs. 4, 8). As clearly seen, the connector of Hilterbrick is not disposed “radially outside said slinger alongside said brush holder on a first circumferential side of said brush holder.”

Further, Applicant submits that the Examiner did not provide a requisite motivation for combining Kashihara with Hilterbrick. Therefore, the Office Action did not establish *prima facie* obviousness. Such determination of obviousness is improper.

3. Positioning the voltage regulator, surge absorber, and connector radially outside the slinger alongside the brush holder on a first circumferential side of the brush holder is not obvious

The Examiner contends that it “would have been obvious to have this configuration, since a person of ordinary skill would have been able to rearrange these components and have them disposed radially outside the slinger for the purpose of increasing the cooling efficiency.” (See Office Action, page 3, last full paragraph).

a. The proposed modification would render Kashihara unsatisfactory for its intended purpose

Kashihara is directed to a capacitor for a car AC generator which improves assembly work efficiency and reduces a vibration load on the connection portions of the element terminals of the capacitor element and the terminals of the resin part, wherein a resin part installed in the inside space of a generator case has a one-end open bottomed cylinder-like container portion and resin side terminals around the opening portion of the container portion. (Abstract.)

Accordingly, Kashihara's invention is directed to positioning the capacitor in a certain manner in a certain container proximate to the slinger and providing the terminals for the capacitor to connect to other components. Rearranging the location of the capacitor, therefore, will defy the entire purpose of Kashihara's invention. Accordingly, the entire subject of Kashihara's invention will lack its intended purpose. Therefore, there is no teaching, suggestion or motivation in Kashihara or in the knowledge generally available to one skilled in the art at the time the invention was made to modify Kashihara to position the voltage regulator, surge absorber, and connector radially outside the slinger alongside the brush holder on a first circumferential side of the brush holder.

Additionally, it is not understandable (nor is the proper reasoning provided in the Office Action) why one skilled in the art would have desired so to modify Kashihara to arrive at the subject matter of claim 12.

b. The Examiner uses an impermissible hindsight

Applicant submits that the Examiner's conclusion of obviousness is based on improper hindsight including only the knowledge gleaned from the Applicant's own disclosure. However, "[i]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." (See MPEP § 2142)

The Examiner has formulated grounds of rejection which, at first blush, appear to be based on actual prior art disclosure, but instead are based on a hindsight rationale that anyone who is familiar with alternators could have positioned the voltage regulator, surge absorber, and connector radially outside the slinger alongside the brush holder on a first circumferential side of the brush holder. The Examiner provides no objective evidence substantiating his position. Such determination of obviousness is improper.

c. It is not obvious to rearrange the voltage regulator, surge absorber, and connector for the purpose of increasing the cooling efficiency

It is alleged in the Office Action that it would have been obvious "to rearrange the voltage regulator, surge absorber, and connector for the purpose of increasing the cooling efficiency."

(See page 3.) Applicant respectfully disagrees. Applicant was first to discover that rearranging the voltage regulator, surge absorber, and connector would substantially improve cooling as described, for example, in the specification, on page 2, lines 11-22, and page 24, lines 1-7.

The Examiner's position is based on Applicant's disclosure and is not rooted in the prior art of record. Furthermore, since an exemplary rearrangement improves the cooling efficiency, as discovered by the Applicant, the exemplary arrangement cannot be a matter of obvious design choice.

Moreover, the Examiner's attempt to support his subjective application of a *per se* "design choice" rule is improper. In particular, "[t]his method of analysis is founded on legal error because it substitutes supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." In re Ochiai, 71 F.3d 1565, 1570, 37 U.S.P.Q.2D (BNA) 1127, 1132 (Fed. Cir. 1995) In fact, in In re Ochiai, the Court provided a detailed clarification of what it perceived to be a frequent misunderstanding among examiners.

The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention--including all its limitations--with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on per se rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to Graham and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any per se rules of obviousness, just as those precedents themselves expressly declined to create such rules. Any conflicts as may be perceived to exist derive from an impermissible effort to extract *per se* rules from decisions that disavow precisely such extraction. (Emphasis added). In re Ochiai, 71 F.3d 1565, 1572, 37 U.S.P.Q.2D (BNA) 1127, 1134 (Fed. Cir. 1995).

4. In summary, (1) because neither Kashihara, nor Hilterbrick, taken singularly or in combination, teaches or suggests at least “said voltage regulator, said surge absorber, and said connector are disposed radially outside said slinger alongside said brush holder on a first circumferential side of said brush holder,” and (2) because there is no teaching, suggestion or motivation in Kashihara, Hilterbrick, or in the knowledge generally available to one skilled in the art at the time the invention was made to modify Kashihara or combine it with Hilterbrick to position the voltage regulator, surge absorber, and connector radially outside the slinger alongside the brush holder on a first circumferential side of the brush holder, **claim 12 and dependent claims 13-22** distinguish patentably and unobviously over Kashihara and Hilterbrick.

Claims 15, 16, 18 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashihara (U.S. Patent No. 6,236,557) in view of Adachi (U.S. Patent No. 5,550,415).

Claims 15, 16, 18 and 22 depend on claim 12. Applicant notes that the Examiner conceded that Kashihara lacks a connector. (*See* Office Action, page 3, lines 5-6). Additionally, Applicant has already demonstrated that Kashihara does not meet all of the features of independent claim 12. Adachi does not compensate for any of the deficiencies of Kashihara. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 12. Since **claims 15, 16, 18 and 22** depend on claim 12, they are patentable at least by virtue of their dependency.

Additionally, **Claim 15** recites among other elements: “a plurality of insert conductors which are insert molded into said resin body to be exposed at said first axial end and including: a voltage regulator connecting terminal to connect to the exposed IC circuit connecting terminals at the first axial end, and a surge absorber connecting to connect to said exposed surge absorber connecting terminals at said first axial end.” Applicant respectfully submits that a combination of Kashihara and Adachi lacks these elements. If the Examiner maintains his assertion, Applicant requests the Examiner to provide a citation to the description of these features in Adachi or in Kashihara. Otherwise, Applicant respectfully requests this ground of rejection of claim 15 be withdrawn.

Further, **Claim 18** recites among other elements: “wherein the IC circuit includes connecting terminals exposed outside of the voltage regulator and wherein the surge absorber includes connecting terminals exposed outside of the surge absorber,... a plurality of insert conductors which are insert molded into said resin body to be exposed at said first axial end of the slinger and including: a voltage regulator connecting terminal to connect to the exposed IC circuit connecting terminals at the first axial end of the slinger, and a surge absorber connecting terminal to connect to said exposed surge absorber connecting terminals at said first axial end of the slinger.” Applicant respectfully submits that a combination of Kashihara and Adachi lacks these elements. If the Examiner maintains this assertion, Applicant requests the Examiner to provide a citation to the description of these elements in Adachi or in Kashihara. Otherwise, Applicant respectfully requests this ground of rejection of claim 18 be withdrawn.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashihara (U.S. Patent No. 6,236,557) in view of Adachi (U.S. Patent No. 5,550,415), and further in view of Nikawa (U.S. Patent No. 6,291,913).

Claim 19 depends on claim 18. Applicant notes that the Examiner conceded that Kashihara lacks a connector. (*See* Office Action, page 3, lines 5-6). Additionally, Applicant has already demonstrated that Kashihara and Adachi do not meet all of the features of claim 18. Nikawa does not compensate for the above-identified deficiencies of these references. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 18. Since **claim 19** depends on claim 18, claim 19 is patentable at least by virtue of its dependency.

Claims 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashihara (U.S. Patent No. 6,236,557) in view of Nikawa (U.S. Patent No. 6,291,913).

Claims 20-21 depend on claim 12. Applicant notes that the Examiner conceded that Kashihara lacks a connector. (*See* Office Action, page 3, lines 5-6). Additionally, Applicant has already demonstrated that Kashihara does not meet all of the features of independent claim 12. Nikawa does not compensate for the above-identified deficiencies of Kashihara. Together, the

combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 12. Since **claims 20-21** depend on claim 12, they are patentable at least by virtue of their dependency.

IV. Allowed Claim 23

Applicants sincerely thank the Examiner for indication of the allowance of Claim 23.

V. New Claims

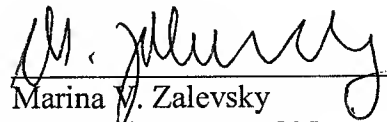
In order to provide more varied protection, Applicant adds **claim 24**, which is patentable at least for analogous exemplary reasons set forth above regarding claim 1. No new subject matter has been entered.

VI. CONCLUSION

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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